

REMARKS

Applicant thanks the Examiner for indicating that claim 5 contains allowable subject matter.

I. Introduction

Claims 1-19 and 22-23 are pending in the above application.

Claims 1, 6-9, 17 and 22-23 stand rejected under 35 U.S.C. § 102.

Claims 2-4, 10-16 and 18-19 stand rejected under 35 U.S.C. § 103.

Claim 5 stands objected to as containing allowable subject matter but being dependent on a rejected claim.

Claims 1, 9, 17, 18, and 22 are independent claims.

II. Prior Art Rejections

Claims 20-21 have been canceled without prejudice or disclaimer.

Claims 1, 9, 17, 18, 22, and 23 have been amended to more particularly point out that which Applicant regards as the inventions therein.

No new matter has been added.

III. Prior Art Rejections

A. Claims 1, 6-9, 17 and 22-23 stand rejected under 35 U.S.C. § 102 as being anticipated by Lin et al. (U.S. Pat. 6,603,849).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int'l Trade*

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Commission, 808 F.2d 1471 (Fed. Cir. 1986); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Lin does not disclose or suggest a method of seamlessly transferring an ongoing communication session between a first device and a correspondent device on an IP network to another device via the IP address of the first device. Lin merely discloses to forward a telephone call from one network element to another network element to allow a mobile unit to complete a call when it roams out of its network or to connect to a pre-designated secondary device before establishing the call. See, col. 3: 25 through col. 4: 44; and col. 5: 13-25. Lin does not disclose to transfer a communication session (i.e. an on-going communication) between a first device and a correspondent device to another device via the IP address of the first device. More particularly, Lin discloses to use alternative numbers associated with the network elements to initially complete a call to a mobile station (MS) 20 or alternative endpoint when it is being serviced by different networks, i.e. the alternative numbers referred to in Lin are concerned with the various network elements required to complete (set up) a call to MS 20 or to another endpoint (or phone), they are not concerned with transferring an ongoing communication session from MS 20 to another user device. See, col. 4: 45 through col. 6: 12. Moreover, Lin does not disclose to use an IP address of MS 20 (if there is any) to transfer an ongoing communication session from itself to another device.

Applicants have further clarified that an ongoing communication session is transferred, whereby a correspondent device is able to communicate with a first device during the communication session. Lin clearly is focused on setting up the call, i.e. completing a call. All transfers discussed in Lin are prior to creating a communication session. Lin states "in response to initiating a ringing tone on the H.323 endpoint 120, if the H.323 subscriber does not answer

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the call (step 615), the H.323 endpoint 120 transmits the Release Complete message 140 with the re-routing cause 145 back to the Gatekeeper 180 (step 620)." Col. 5: 54-58. Clearly, if the call is not answered

Accordingly, as Lin does not disclose each and every element of any of independent claims 1, 9, 17, 20 or 22, Lin does not anticipate any of these claims. Likewise, since claims 6-8 depend on claim 1 and incorporate all of the limitations thereof, and claim 21 depends on claim 20 and incorporates all of the limitations thereof, Lin does not anticipate these claims as well. Hence, Applicant respectfully requests the rejection to be withdrawn.

B. Claims 2-4 and 10-16 stand rejected under 35 U.S.C. § 102 as being anticipated by Lin in view of Patel (U.S. Pat. 6,591,364).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Neither Lin nor Patel, taken alone or in combination disclose or suggest all of the limitations of claims 2-4 or 10-16, which depend on and incorporate the limitations of claims 1 and 9, respectively. Lin does not disclose the limitations of either claims 1 or 9 as discussed

above. Patel also does not disclose such, and the Office action does not rely on Patel as disclosing such.

Accordingly, as neither Lin nor Patel, taken alone or in combination do not disclose or suggest all of the claimed limitations of claims 2-4 nor 10-16, the combination of Lin and Patel does not render these claims unpatentable.

C. Claims 18-19 stand rejected under 35 U.S.C. § 102 as being unpatentable over Lin in view of Johnston (U.S. Pat. 6,373,946).

Neither Lin nor Johnson, taken alone or in combination disclose or suggest transferring a communication session between a transferring node and a correspondent node to a target node, which includes negotiating a session transfer, generating a random number to serve as session key. Lin does not disclose to transfer a session to another device as discussed above. Johnson also does not disclose such, and the Office action does not rely on Johnson as disclosing such.

Accordingly, as neither Lin nor Johnson, taken alone or in combination do not disclose or suggest all of the claimed limitations of claim 18, nor claim 19 which depends on claim 18, the combination of Lin and Patel does not render these claims unpatentable.

IV. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

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